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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,091	07/14/2003	William R. Schmeling	19596-0541 (45738-286749)	8595
23370 7590 06/14/2007 JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309				
EXAMINER HYUN, PAUL SANG HWA				
ART UNIT PAPER NUMBER 1743				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/619,091

Applicant(s)

SCHMELING, WILLIAM R.

Examiner

Paul S. Hyun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 16, 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

REMARKS

Claims 1-8, 16 and 18-23 are currently pending. Applicant amended claims 1 and 6.

The double patenting objection to claim 17 has been withdrawn in light of the cancellation of claim 17.

Despite Applicant's arguments and the amendments, the art rejections are maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Rohr (US 5,445,971).

Rohr discloses a test kit comprising a reaction vessel with magnetically-attractable label disposed thereon for conducting binding assays (see lines 45-58, col. 2), wherein the reaction vessel can be a test strip (see line 17, col. 14). The labels are physically bound to a location of the test strip such that the test strip moves and adopts a specific spatial orientation when the test strip is exposed to a magnetic field (see lines 36-68, col. 19 and Fig. 4).

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-3, 16 and 17** are rejected under 35 U.S.C. 102(e) as being anticipated by Hagen et al. (US 6,872,358 B2).

Hagen et al. disclose a test strip dispenser wherein the test strips to be dispensed are rectangular and flat (see lines 40-50, col. 5 and Fig. 2A). To dispense a test strip, the dispenser utilizes a magnet to engage a magnetic material disposed at an end or an edge of a test strip and moves the test strip away from the stack of test strips housed within the dispenser (see lines 1-23, col. 15). When the magnet engages the test strip, the test strip adopts a specific orientation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **4 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. in view of Hegedus (US 3,384,093).

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Hagen et al. do not disclose that the magnetic means attached to each test strip is in the form of a tape.

Hegedus et al. disclose a filing card cabinet in which the filing cards are withdrawn from the filing cabinet by means of a magnetic rod 8 that engages a metallic strip 6 affixed to each filing card.

In light of the disclosure of Hegedus et al., it would have been obvious to one of ordinary skill in the art to make the magnetic means affixed to the test strips disclosed by Hagen et al. in the form of metallic strips since metallic strips are thin, and are well suited for attaching to flat articles.

It also would have been obvious to one of ordinary skill in the art to form the metallic strip out of iron since iron is abundant and well-known to be responsive to magnetic fields.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. in view of Caladine (GB 2 170 780 A).

Hagen et al. do not disclose the step of counting the test strips as they move in response to the magnetic field.

Caladine discloses a dispenser comprising a counter 41 that counts the number of times the dispenser has dispensed an article (see lines 30-38, page 1). The reference discloses that it is desirable to count the number of times a dispenser has dispensed an article for the purposes of detecting theft or malfunction (see lines 8-25, page 1).

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In light of the teachings of Caladine, it would have been obvious to one of ordinary skill in the art to provide the dispenser disclosed by Hagen et al. with a counter such that the dispenser counts the number of times a test strip has been dispensed so that theft or malfunction can be detected.

Claims **19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. in view of Caladine as applied to claim 18 above, and further in view of Nambu (US 5,444,749).

Neither Hagen et al. nor Caladine disclose that the counting is accomplished by monitoring the changes in the weight of the container as the test strips are dispensed.

Nambu discloses an article dispensing system comprising a weight meter 9 that measures the weight of the articles dispensed into a container 8. The weight meter communicates with an operation unit 14 that calculates the number of articles dispensed based on the weight of articles dispensed and the weight of each individual article (see lines 4-13, col. 8).

In light of the teachings of Nambu, it would have been obvious to one of ordinary skill in the art to provide the modified dispenser disclosed by Hagen et al. and Caladine with a weight meter such that the weight meter monitors the changes in the weight of the dispenser in order to provide another means for counting the number of test strips dispensed by the dispenser.

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Claims **1, 6-8, 16 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over van Rijckevorsel et al. (US 4,578,716) in view of Casner (US 3,623,603).

Van Rijckevorsel et al. disclose a test strip as well as a method for sorting out faulty test strips from the suitable test strips during manufacturing process. The reference discloses that faulty test strips can be sorted out from the superior test strips by marking them and manually removing them (see lines 17-20, col. 8). The reference differs from the claimed invention in that the reference does not disclose the use of a magnetic field to sort the test strips.

Casner discloses that it is well known in the art to separate defective articles from non-defective articles by labeling the defective articles with a magnetic label and applying a magnetic field to the entire batch to isolate the defective articles (see lines 1-20, col. 2). The reference discloses that this method eliminates human error associated with manual sorting.

In light of the disclosure of Casner, it would have been obvious to one of ordinary skill in the art to mark the faulty test strips disclosed by van Rijckevorsel et al. with magnetic labels and separate the faulty test strips from the superior test strips by means of a magnetic field in order to eliminate human error associated with manual sorting.

Claim **21** is rejected under 35 U.S.C. 103(a) as being unpatentable over van Rijckevorsel et al. in view of Casner as applied to claims 1, 6-8, 16 and 18, and further in view of Werderitch et al. (US 4,387,064).

Neither van Rijckevorsel et al. nor Casner disclose the step of counting the test strips.

Werderitch et al. disclose a method for sorting defective articles from non-defective articles (see lines 1-10, col. 2). The method comprises counting the number of defective articles produced during the manufacturing process in order to determine the efficiency of the manufacturing process.

In light of the disclosure of Werderitch et al., it would have been obvious to one of ordinary skill in the art to provide the step of counting the number of defective test strips to the modified method disclosed by van Rijckevorsel et al. and Casner so that manufacturing efficiency can be determined.

Claims **22 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over van Rijckevorsel et al. in view of Casner and Werderitch et al. as applied to claim 21, and further in view of Bonnet (US 5,896,999).

Neither van Rijckevorsel et al., Casner nor Werderitch et al. disclose counting test strips by monitoring changes in the gross weight of the test strips as they are moved.

Bonnet discloses a method for sorting articles into bags in which the articles to be sorted are counted based on the change in the weight of the bags (see claim 13).

In light of the disclosure of Bonnet, it would have been obvious to one of ordinary skill in the art to count the number of defective test strips based on the weight of the defective test strips moved into or out of container rather than actually counting the test

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strips. Articles that are small or numerous in number are easier to quantify by measuring the weight of the bulk rather than counting individual articles.

Response to Arguments

Applicant's arguments with respect to the art rejections have been fully considered but they are not persuasive.

Applicant argues that the test strip recited in claim 1 and the method recited in claim 16 are patentable over the test strip and method disclosed by Rohr for two reasons:

1) The test strip disclosed by Rohr is not made from a magnetic material. Rather, the test strip comprises magnetic particles bound to the test strip; and

2) Rohr does not explicitly disclose that the test strip adopts a specific spatial orientation when exposed to a magnetic field.

These arguments are not persuasive.

Applicant's first argument is not persuasive because the claim does not recite that the test strip itself is made from a magnetic material. The claim merely recites that the test strip comprises a magnetically attractive material at one or more locations of the test strip. As indicated in the rejection above, the test strip disclosed by Rohr comprises magnetic particles BOUND to the test strip. The Examiner maintains the position that the test strip/magnetic particles disclosed by Rohr anticipates the scope of the claims.

Applicant's second argument is also not persuasive because Rohr does show the test strip adopting a specific orientation when the test strip is subjected to a magnetic

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field (see Fig. 4). The Examiner maintains the stance that the position of the test strip shown in Figure 4 of Rohr anticipates the "orientation" recited in the claims.

Applicant argues that the test strip recited in claims 1-3 and 16 is patentable over the test strip disclosed by Hagan et al. This argument is not persuasive. First, the scope of the limitation "aligning or orienting" recited in claim 16 is broad enough that the position adopted by the disclosed by Hagan et al. in response to a magnet is within the scope of the claims. Second, even if the orientation of the Hagan et al. test strip induced by the magnet is not within the scope of the limitation "specific orientation" recited in claim 1, it should be noted that the limitation "such that...when exposed to a magnetic field" recited in the claim is directed towards intended use, which has no patentable significance. Specifically, the limitation merely recites that the claimed test strip is **capable** adopting a spatial orientation **when** it is exposed to a magnetic field.

Therefore, regardless of the movement displayed by the test strip as disclosed by Hagan et al., the Examiner maintains the position that if the test strip was subjected to and manipulated by a magnetic field, the test strip **would** adopt a specific orientation.

Applicant argues that the test strip recited in claims 1, 6-8, 16 and 18 is patentable over the modified test strip disclosed by Rijckevorsel et al. and Casner because the test strip disclosed by Rijckevorsel et al. and Casner do not adopt a specific orientation when exposed to a magnetic field. This argument is not persuasive because the scope of the limitation "aligning or orienting" recited in claim 16 is broad enough that the orientation exhibited by the modified test strips if they are sorted out by a magnet as disclosed by Rijckevorsel et al. and Casner is within the scope of the claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSH
6/8/07


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